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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/369,570	08/06/1999	MARCELLO TONCELLI	DRAGO-P86-RE	6991

7590 09/29/2004

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SCARSDALE, NY 10583

EXAMINER
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AFTERGUT, JEFF H

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/369,570	<b>Applicant(s)</b> TONCELLI, MARCELLO	
	<b>Examiner</b> Jeff H. Aftergut	<b>Art Unit</b> 1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 39-45, 52-54 and 58-73 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 39-45, 52-54, 58-73 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

***Reissue Applications***

1. This application is objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01.

A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action.

2. This application is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest in order to support the consent to a reissue application required by 37 CFR 1.172(a). The assignee's ownership interest is established by:

(a) filing in the reissue application evidence of a chain of title from the original owner to the assignee, or

(b) specifying in the record of the reissue application where such evidence is recorded in the Office (e.g., reel and frame number, etc.).

The submission with respect to (a) and (b) to establish ownership must be signed by a party authorized to act on behalf of the assignee. See MPEP § 1410.01.

An appropriate paper satisfying the requirements of 37 CFR 3.73 must be submitted in reply to this Office action.

3. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 65-73 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 65, the applicant recites that the non-linear reinforcing elements are disposed within the grooves or recesses provided on the substantially smooth rear face of the stone material (which was recited as being free of grooves or recesses). Claim 39 requires that a reinforcing material be disposed between the coated non-twisted linear reinforcing elements and the rear of the stone material. As such, claim 65 therefore requires that a reinforcing layer be disposed in the grooves as well as the non-twisted linear reinforcing elements. This, however, is simply not described in the original disclosure. The original disclosure did describe that one had non-twisted linear reinforcing elements in the grooves or recesses, however there was no description of having an additional reinforcing layer in the grooves or recesses between the non-twisted linear reinforcing elements and the stone slab. Additionally, applicant is advised that the use of grooves on the rear of the slab of stone appears to be a separate and independent species from that where the rear of the stone slab was free of grooves and recesses, see column 3, lines 6-58. It should be noted that housing

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the non-twisted linear reinforcement in the grooves would not "envelope" the "conventional reinforcement" disposed in the grooves. As previously discussed, it is suggested if applicant wishes to claim the other species that such should be presented as a separate independent claim.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 65-73 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not seen how one can claim that the stone slab is free of grooves and recesses in claim 39 and then recite that the stone slab has grooves or recesses into which the linear non-twisted reinforcement was disposed. The stone slab either has grooves or it doesn't have grooves. The claims are not clear and concise in nature as presented. As discussed above, as the embodiment where grooves are present is a separate species from the embodiment where grooves or recesses are not present, it is suggested that applicant provide claim 65 as an independent claim.

***Claim Rejections - 35 USC § 103***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 39-45 and 52-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent 6-64076 in view of Webster's II New Riverside University Dictionary and any one of Japanese Patent 4-231545, PCT WO 91/09733 or

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French Patent 2429100 for the same reasons as expressed in the Office action dated September 8, 2003, paragraph 6.

10. Claims 58-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as set forth above in paragraph 9 further taken with Japanese Patent 63-242984 for the same reasons as expressed in the Office action dated September 8, 2003, paragraph 7.

11. Claims 65-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over E.P. 631,015 in view of E.P. 623,714 further taken with Japanese Patent 6-64076, Webster's II New Riverside University Dictionary and any one of Japanese Patent 4-231545, PCT WO 91/09733 or French Patent 2429100 for the same reasons as expressed in the Office action dated September 8, 2003, paragraph 8.

### ***Double Patenting***

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 39-45 and 52-54 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, and 11 of

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U.S. Patent No. 6,205,727 in view of Japanese Patent 6-64076, Webster's II New Riverside University Dictionary and any one of Japanese Patent 4-231545, PCT WO 91/09733 or French Patent 2429100 for the same reasons as expressed in the Office action dated September 8, 2003, paragraph 10.

14. Claims 58-64 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, and 11 of U.S. Patent No. 6,205,727 in view of Japanese Patent 6-64076, Webster's II New Riverside University Dictionary any one of Japanese Patent 4-231545, PCT WO 91/09733 or French Patent 2429100 and Japanese Patent 63-242984 for the same reasons as expressed in the Office action dated September 8, 2003, paragraph 11 .

#### ***Response to Arguments***

15. Applicant's arguments with respect to claims 39-45, 52-54, 58-73 have been considered but are moot in view of the new ground(s) of rejection.

Applicant is advised regarding the double patenting rejection that while the applicant is correct in their argument that the term of the patent will not extend beyond that of the patent which was used to reject the claims under double patent, there is another aspect to the doctrine of double patenting which applicant is not meeting. The doctrine of double patenting requires that the two patent be licensed together so as to not create a situation where one company has license to one patent and another to the other patent wherein the two companies can get involved in litigation against each other over the same inventive concept. As such, a terminal disclaimer is still required in this

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application so that such licensing issues do not arise. Applicant is referred to MPEP 804 and 804.02:

“Applicants are cautioned that reliance upon a common issue date cannot effectively substitute for the filing of one or more terminal disclaimers in order to overcome a proper double patenting rejection, particularly since a common issue date alone does not avoid the potential problem of dual ownership of patents to patentably indistinct inventions.”

The applicant is advised that a terminal disclaimer is still required in this application.

Regarding the prior art rejection, the applicant argues that the reference to Japanese Patent '076 as teaching non-twisted reinforcing elements therein and therefore all of the claims are held to define over the prior art of record. The applicant is advised that the layer 104 of Japanese Patent '076 was referred to as a woven fabric or cloth (note that the layer which applicant defined as containing the non-twisted linear reinforcement was a layer which was a matting. As expressed in the previous Office action, a matting is a coarsely woven fabric (as established by the definition from Webster's II New Riverside University Dictionary. Applicant has not disputed the provided definition. The references to any one of Japanese Patent '545, PCT '733 or French Patent '100 all suggested that either a matting was a known and useful reinforcement for a stone slab or that a coarsely woven fabric would have been useful (see the previous Office action, note that applicant did not address the same and therefore it is again deemed that applicant agrees with the Office interpretation of these references). It therefore seems to reason that the woven fabric in Japanese Patent '076 would have been a coarsely woven fabric (or matting) for reinforcement of the back of the stone slab. The applicant is advised that as such, the prior art did in fact suggest

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that one skilled in the art would have formed a fabric reinforcement which was a matting. Note that applicant has defined that the reinforcement which consists of the non-twisted liner reinforcement was a matting. As such, the prior art of record envisioned the use of non-twisted liner reinforcement for the stone slabs therein.

Regarding the rejection based upon 35 USC 251, the applicant is advised that this rejection has been removed. As newly presented claim 65 (as amended) does not clearly define that there are grooves or recesses on the backside of the slab (as claim 39 from which it depends requires that the slab be free of the grooves or recesses). As such, the claim is not recapturing subject matter which was relinquished in the patent. It should be noted that if applicant presents the claim in independent form (which is what should be done as addressed above as the use of grooves or recesses is deemed from previous prosecution to be a different embodiment (i.e. species) of the invention), the rejection under 35 USC 251 (recapture) will be made again.

### ***Conclusion***

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the


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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff H. Aftergut whose telephone number is 571-272-1212. The examiner can normally be reached on Monday-Friday 7:15-345 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on 571-272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jeff H. Aftergut  
Primary Examiner  
Art Unit 1733

JHA  
September 27, 2004